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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,458	02/28/2002	Haixing Wan	009679-054	4976

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 08/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/084,458	WAN, HAIXING
Examiner	Art Unit	
Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 July 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 and 22-24 with respect to the applied speices is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

This is in response to Paper filed on 30 July 2003.

I. (1) It is allowed to claim by a functional, characteristic, physical and/or chemical property of a material and /or process (In re Swinehart, 169 USPQ 226). (2) However, a claimed functional, characteristic, physical and/or chemical property of a material and/or process carries with a risk (In re Swinehart, 169 USPQ 228). Therefore, one should be carefully looked into it for his own benefit. Please also see In re Schreiber, 44 USPQ2d 1432 since it is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. The language "an iron-containing precipitate...at about room temperature", " an iron-containing precipitate...4<sup>0</sup>C" or " an iron-containing precipitate...50<sup>0</sup>C" or the like is considered as the functional, characteristic, chemical and physical property of a material and process.

(2) Within the authority of the Office being granted by the authority in the court of law, applicant is required to show or provide an evidence to the contrary to the applied material and process from the applied reference for the claimed property of the material and process as claimed for its patentability in accordance with the authority stated in In re Swinehart, 169 USPQ 228. It is should be noted that an argument alone (1) would be taken a place of an objective evidence as a matter of law (2) has and (3) is given a little to no value.

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(3) In re Schreiber, 44 USPQ2d 1429 state that "A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart... 169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in Swinehart... where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on."

II. Claims 1-12 and 22-24 with respect to the elected and applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuykendall et al (6,534,253).

Kuykendall et al disclose, teach and suggest a method for making or obtaining a ferric ( $\text{Fe}^{+++}$ , Fe III or iron III) 1,3-propylenediaminetetraacetate or its adjacent homologue, ferric ( $\text{Fe}^{+++}$ , Fe III or iron III) ethylenediaminetetraacetate, comprising the step of (1) combining a ferrous ( $\text{Fe}^{++}$  or Fe II or iron II) salt selected from ferrous bromide with a alkylenepolyaminopolycarboxylic acid selected from 1,3-propylenediaminetetraacetic acid or its adjacent homologue, ethylenediaminetetraacetic acid to make or obtain up to 100% of ferrous 1,3-propylenediaminetetraacetate or its adjacent homologue, ferrous ethylenediaminetetraacetic acid and (2) and oxidizing the ferrous 1,3-propylenediaminetetraacetate to make or obtain ferric 1,3-propylenediaminetetraacetate as claimed or its adjacent homologue, ferric ethylenediaminetetraacetate. Please see the whole disclosure of the applied reference, especially at col.4:47-52, 5:43-45, 7:5 and 13-17, 8:65 to 9:25, 10:7-9 and Examples. For the newly added

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embodiment, "wherein the steps...a color photographic material, please see Kuykendall et al at col.9:4-12 that ferrous ions are oxidized to be ferric ion in a line with air or oxygen in a delivery line to a processing chamber. Since Kuykendall et al disclose, teach and suggest the requisite processing steps and the requisite chemicals for use in the processing steps as the main and essential embodiments of the claims, claims 1-12 and 22-24 with respect to the elected and applied species are found to be rendered prima facie obvious by Kuykendall et al.

**III.** Applicant's arguments filed 30 July 2003 have been fully considered but they are not persuasive.

Applicant fails to recognize that Kuykendall et al disclose, teach and suggest ferric ions are oxidized to be ferric ions in a line with air or oxygen in a delivery line to a processing chamber at col. 9:4-12.

**IV. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers of the examiner is 703-746-7172. Since there is a newly electronic filing procedure for all initial communicating papers and all responses to an Office action, the examiner fax phone number is not for use to receive any fax in response to an Office action. Applicant is requested and required to send all initial communicating papers and all response to Office action to a central paper or fax receiving center for an electronic scanning procedure.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
04 August 2003

HOA VAN LE  
PRIMARY EXAMINER

Hoa Van Le